

## REMARKS

In response to the Notice of Non-Compliant Amendment mailed on April 6, 2007, Applicant has corrected the status identifier of claim 31 to recite "currently amended" as opposed to "previously presented."

### Claim Rejections Under 35 U.S.C. §112, second paragraph

The Examiner has rejected Applicant's claim 18 for allegedly being indefinite because the phrase "insulation layer loose laid over primary waterproofing membrane" is confusing. Applicant respectfully traverses. The primary membrane in this claim is meant to support the insulation layer, and the secondary membrane is meant to be supported by the energy absorbing layer.

### Claim Rejections Under 35 U.S.C. §102(b)

Claims 18-20 have been rejected under 35 U.S.C. §102(b) as being anticipated by Kelly et al. U.S. Patent No. 6,006,482 hereinafter referred to as "Kelly."

Applicant's amended claim 18 recites *inter alia*: "an energy absorbing layer supported by said insulation layer, wherein said energy absorbing layer is of a different material than said insulation layer." Kelly does not teach an energy absorbing layer that is of a different material than the insulation material. Instead, referring to Figure 31, Kelly teaches two insulation layers that are each identified by the reference numeral 14. As such, these layers are implied to be of the same material. Therefore, since Applicant's amended claim 18 teaches an energy absorbing layer that is of a different material than the insulation layer, Kelly does not teach all of the elements of Applicant's claim 18, or claims 19 and 20 that depend therefrom.

Furthermore, Applicant's amended claim 18 also recites *inter alia*, "a primary waterproofing membrane disposed over at least a substantial portion of said roof deck or air seal substrate...and a secondary waterproof membrane loose laid over said energy absorbing layer." Kelly does not teach two membranes that comprise a loose laid membrane and another membrane disposed over a substantial portion of the roof deck. Instead, Kelly teaches gummy rope 112, which the Examiner equates with the membrane disposed over a substantial portion of the roof

deck. If, *pro arguendo*, Applicant were to admit that the gummy rope 112 could be considered a membrane (Applicant respectfully submits that this admission is not made) this gummy rope 112, as shown in Figure 31, is taught to only cover a small portion of the roof deck. As Applicant's amended claim 18 teaches a primary waterproofing membrane disposed over at least a substantial portion of the roof deck or air seal substrate, Kelly does not teach all of the elements of Applicant's claim 18, or claims 19 and 20 that depend therefrom.

For at least the above reasons, Applicant respectfully submits that the 102 rejection is overcome.

#### Claim Rejections Under 35 U.S.C. §103

Claims 1-2, 6, 9-17, and 22-30 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Kelly, and Kelly in view of United States Patent No. 5,560,150 to Pearson ("Pearson" hereinafter).

Applicant's amended claims 1 and 17 recite *inter alia*: "an energy absorbing layer supported by said insulation layer, wherein said energy absorbing layer is of a different material than said insulation layer." Kelly does not teach an energy absorbing layer that is of a different material than the insulation material. Instead, referring to Figure 31, Kelly teaches two insulation layers that are each identified by the reference numeral 14. As such, these layers are implied to be of the same material. Therefore, since Applicant's amended claims 1 and 17 teach an energy absorbing layer that is of a different material than the insulation layer, Kelly does not teach all of the elements of Applicant's claims 1 and 17, or claims 2, 6, 9-16, and 22-30 that depend respectively therefrom.

Furthermore, Applicant respectfully submits that there is no motivation to combine Pearson with Kelly, as Pearson has nothing to do with roofing or roof decks, and even if it did, Pearson would not remedy the deficiencies of Kelly.

Claims 3, 4-5, 7-8, and 21 have also been variously rejected over Kelly or combinations of Kelly with United States Patent No. 6,250,036 to Nurley ("Nurley" hereinafter), United States Patent No. 6,006,482 to Bennett ("Bennett" hereinafter), and Pearson.

Since claims 3, 4-5, 7-8, and 21 depend from claim 1, for at least the reasons set forth above, none of claims 3, 4-5, 7-8, and 21 are obvious over Kelly. Though Bennett will be discussed in greater detail below, since none of Nurley, Bennett, and Pearson remedy the deficiencies of Kelly as discussed above, Applicant respectfully submits that none of claims 3, 4-5, 7-8, and 21 are obvious over the various combinations of Kelly, Nurley, Bennett, and Pearson either.

Claim 31 been rejected under 35 U.S.C. §103(a) as being unpatentable over Kelly in view of Pearson, and Bennett. Applicant respectfully traverses.

The Examiner alleges that it would have been obvious to modify the lower insulation 14 of Kelly to be made of the polystyrene foam of Bennett in order to teach gypsum board disposed upon an insulation layer composed of at least one of expanded polystyrene (EPS) and polyisocyanurate foam (ISO).

Applicant respectfully submits that there is no motivation to make this modification and combination of Kelly and Bennett, referring the Examiner to MPEP 2145(X)(B), which states that,

“The admonition that 'obvious to try' is not the standard under § 103 has been directed mainly at two kinds of error. In some cases, what would have been 'obvious to try' would have been to vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful.... In others, what was 'obvious to try' was to explore a new technology or general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it." *In re O'Farrell*, 853 F.2d 894”

Neither Kelly nor Bennett teach any parameters or direction that would be critical to deciding why different types of insulation (of which there are many types) would be successful in a roof, or in a roof successful in conjunction with each other. These disclosures certainly do not teach a manner by which gypsum would interact on top of polystyrene to allow for energy absorption, as recited in Applicant's claim 31. The Examiner is simply trying one type of insulation (polystyrene foam) with another (gypsum) with no objective evidence other than the

statement that polystyrene foam "would provide good insulation for the roof structure of [Kelly]." However, Applicant respectfully contends that this polystyrene is just one of many possible choices that could be tried for providing good insulation for a roof structure."

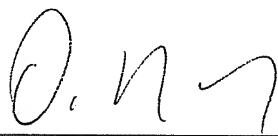
Therefore, Applicant respectfully submits that the Examiner has erroneously modified and combined the gypsum board embodiment of Kelly with the polystyrene foam of Bennett to teach the gypsum board disposed upon an insulation layer composed of at least one of expanded polystyrene (EPS) and polyisocyanurate foam (ISO) recited in Applicant's claim 31.

All of the rejections are herein overcome. No new matter is added by way of the present Remarks, as support is found throughout the original filed specification, claims, and drawings. Notice of Allowance is respectfully requested.

If the Examiner has any questions regarding the instantly submitted response, Applicant's attorney respectfully requests the courtesy of a telephone conference to discuss any matters in need of attention.

If there are any additional charges with respect to this response or otherwise, please charge them to Deposit Account No. 06-1130 maintained by Applicants' attorney.

Respectfully submitted,  
Cantor Colburn LLP

By: 

Daniel R. Gibson  
Registration No. 56,539  
55 Griffin Road South  
Bloomfield, CT 06002  
Telephone: (860) 286-2929  
Facsimile: (860) 286-0115  
Customer No. 23413

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